UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
LEWIS, CHERYL RENEA

ART UNIT	PAPER NUMBER
2177	

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

	Application No.	Applicant(s)
Office Action Summary	09/717,529	ATZEL, AMY HOBBS
	Examiner	Art Unit
	Cheryl Lewis	2177

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *6/30/2003, paper no. 5* .

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-47* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-47* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☒ The proposed drawing correction filed on *30 June 2003* is: a)☒ approved b)☐ disapproved by the Examiner.

   If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____ .

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

   a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *6* .

4)☐ Interview Summary (PTO-413) Paper No(s). _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: .

Response to Amendment

1.   This Office action is in response to the applicant's communication received on June 30, 2003, paper no. 5.

2.   Claims 1-47 are presented for examination.

3.   The information disclosure statements filed on August 11, 2003, paper no. 6, complies with the provisions of MPEP § 609. They have been placed in the application file, and the information referred to therein has been considered as to the merits.

4.   The applicant has amended claims 1-4, 9-12, 22; 24, 25, and 35-38.

5.   Applicant's arguments received on June 30, 2003 have been fully considered but they are not deemed to be persuasive.

Response to Arguments

6.   The proposed drawing correction filed on June 30, 2003, paper no. 5 has been approved by the Examiner.

7.   a. On page 5, lines 6-12 of the applicant's arguments, the applicant has argued the following:

'The Applicant has amended each relevant claim to expressly state that the claimed invention retrieves document identified by a unique identifier parsed from the incoming request. Each of the independent claims recites limitations that require at least in part receiving a text and/or data request comprising a unique identifier and unformatted text and/or data, wherein the unique identifier identifies an electronic file, parsing the text request to identify the unique identifier, and requesting the electronic file identified by the unique identifier. The Examiner asserts that <u>Barr et al.</u> teaches or discloses each of these limitations.'

a1. The examiner respectfully disagrees with the applicant's arguments. Barr

teaches retrieving documents identified by a unique identifier (col. 12, lines 57-63, 'For

each search term listed in the document index database 117, document index database

117 stores the document identifiecation number corresponding to each document file

(stored in database 1118) that includes that search term, along with location information

corresponding to the location of the search term in each such document file.'). In fact,

Barr identifies and retrieves documents from a database corresponding to a search

query (Abstract, lines 2 and 3). Figure 4B depicts a display of text and video

information corresponding to document and multi-media files (col. 7, lines 45 and 46).

Figure 4C depicts a composite window in which a user has built a composite document

based on the text and video information in a first and second window (col. 7, lines 53-

56). Figure 5 depicts element 412 a document type field (col. 19, line 12), element 431

a document identification number field (col. 19, lines 16 and 17), and element 434 a

document size field (col. 19, line 38). Therefore, Barr does comprise the means to

retrieve documents identified by a unique identifier. Barr teaches the parsing incoming

request. Barr recites 'when a user of an information searching/retrieval system enters a

search query into the system, the query must be parsed.' (col. 2, lines 20-25). Again,

Barr teaches conversion and parsing of input document information (col. 26, lines 49

and 50). Again, for each of the independent claims, Barr teaches (1) receiving a text

and/or data request (Abstract, line 10, '...receive the search query...', Abstract, line 17,

'...receive the search results information...', Abstract, lines 20 and 21, '...receive a

document retrieval request...') comprising a unique identifier (Figure 5 depicts element

412 a document type field (col. 19, line 12), element 431 a document identification

number field (col. 19, lines 16 and 17), and element 434 a document size field (col. 19,

line 38)) and unformatted text and/or data (figure 9A, elements 908 'Unconverted

image-type information and Unconverted text-type information'), wherein the unique

identifier identifies an electronic file (col.13, lines 8 and 9, '...image text-type information

field" corresponding to each such multi-media file', figure 5, element 432, col. 19, line

37, '...the file identified by field 432...'), parsing the text request to identify the unique

identifier ('when a user of an information searching/retrieval system enters a search

query into the system, the query must be parsed.', col. 2, lines 20-25, col. 26, lines 49

and 50, '...conversion and parsing of input document information...') and requesting the

electronic file identified by the unique identifier (Abstract, lines 22-24, '...the ability to

retrieve a document in response to the retrieval request and transmitting a file

representative of the document...', col. 10, lines 9-15, 'For each search term listed in

the document index database 117, document index database 117 stores the document

identification number corresponding to each document file (stored in image/text

database 118) that includes that search term, along with location information

corresponding to the location of the search term in each such document file.').

   b. On page 6, lines 1-7, of the applicant's arguments, the applicant has argued

'In contrast, the present invention as recited in the above amended claims, the incoming

text is **parsed** to identify one or more unique identifiers. These unique identifiers

themselves uniquely identify the information and documents to be retrieved....'

b1. In response to the above recited argument. Applicant continuously argues 'incoming text', however 'incoming text' is not mentioned or stated in the applicant's claimed language. Applicant argues that the claims have been amended to provide clarity and the claims have been amended to state the "invention retrieves document identified by a unique identifier parsed from the incoming request." (page 5, lines 7 and 8 of the arguments). Nowhere in the amended claims does this text appear. The amended claims only state 'electronic file identified by the unique identifier'. The amended claims only outline 'identified by'. If it is the intention of the applicant to have the claims amended to read on 'incoming request', specifically 'incoming text is parsed' (page 6 of the argument, lines 1 and 2), again 'a unique identifier parsed from the incoming request' (page 5 of the arguments, lines 7 and 8). Then, the applicant needs to amend the claim language to reflect the arguments that appear on pages 5 and 6 of the arguments. Actually, the independent claims recite the following:

'receiving a text request comprising a unique identifier and unformatted text, wherein the unique identifier identifies an electronic file; parsing the text request to identify the unique identifier; and requesting the electronic file identified by the unique identifier.'

The prior art of record, Barr et al. teaches the independent claim limitations for claims 1, 9, 22, and 35 as discussed above. Claims 2-8, 10-21, 23-34, 36-43, and 45-47 are all dependent claims which depend from one of the above independent claims. Each of these claims includes claim limitations corresponding substantially to the above discussed claim limitations and are also addressed by the above remarks.

c. The applicant further argues 'Dependent claim 44 depends from independent claim 35 and as such includes the limitations discussed above not taught or suggested

by <u>Barr et al.</u> <u>Himmel et al.</u>, however, fails to remedy the defeincy of <u>Barr et al.</u> regarding the parsing of a unique identifier that is subsequently used to retrieve desired documents.' (page 6, lines 21 and 22, page 7, lines 1 and 2)

 c1. Again, the applicant is reminded that the examiner has relied on Himmel et al. to teach the Java applet claim limitations only. Nowhere in the Office action does the examiner state that Himmel et al. teaches 'parsing of a unique identifier that is subsequently used to retrieve desired documents'.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

 In claims 1 and 22 the applicant is claiming 'unformatted text'. What is actually meant by 'unformatted text'. The examiner is not clear as to what type of data or text is being unformatted. How is this unformatted text being (1) received in a text request and (2) how is this unformatted text related, defines, or associated with a unique identifier?

 In the interest of compact prosecution, the examiner assumes "unformatted text" corresponds to unconverted text-type information and unconverted image text-type information as identified in the prior art of Barr et al. (5,873,076), the assumed meaning

for 'unformatted text' is identified in figure 9A, elements 908a and 908b. It is assumed

that 'unformatted text' relates to unconverted text-type information.

Claim Rejections - 35 USC § 102

10.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:
        A person shall be entitled to a patent unless --
        (b) the invention was patented or described in a printed publication in this or a
        foreign country or in public use or on sale in this country, more than one year
        prior to the date of application for patent in the United States.

11.   Claims 1-43 and 45-47 are rejected under 35 U.S.C. 102(b) as being anticipated

by Barr et al. (Pat. No. 5,873,076 filed 9/15/1995, hereinafter Barr).

12.   Regarding Claims 1, 9, 35, Barr teaches an architecture for processing search

queries, retrieving documents identified thereby, and method for using same.

        The method and associated system for an architecture for processing search

queries, retrieving documents identified thereby, and method for using same as taught

or suggested by Barr includes:

        receiving a text request (Abstract, line 10, '...receive the search query...',

Abstract, line 17, '...receive the search results information...', Abstract, lines 20 and 21,

'...receive a document retrieval request...', col. 9, line 31 and 32, 'the user of user

station 102 sends a "natural language search query" to data center...') comprising a

unique identifier (Figure 5 depicts element 412 a document type field (col. 19, line 12),

element 431 a document identification number field (col. 19, lines 16 and 17), and

element 434 a document size field (col. 19, line 38)) and unformatted text (figure 9A,

elements 908a-9-8b 'Unconverted image text-type information and Unconverted text-

type information', col. 12, lines 24-35), wherein the unique identifier (col. 13, lines 1-24,

'for each search term listed in the document index database 117, document index

database 117 stores the document identification number corresponding to each multi-media file having an associated text field which includes that search term...') identifies an electronic file (Abstract, lines 22-24, '...the ability to retrieve a document in response to the retrieval request and transmitting a file representative of the document...', col. 10, lines 9-15, 'For each search term listed in the document index database 117, document index database 117 stores the document identification number corresponding to each document file (stored in image/text database 118) that includes that search term, along with location information corresponding to the location of the search term in each such document file.', col. 9, lines 27-53, col. 10, lines 5-15, col. 12, lines 15-67, col. 13, lines 1-24); parsing ('when a user of an information searching/retrieval system enters a search query into the system, the query must be parsed.', col. 2, lines 20-25, col. 26, lines 49 and 50, '...conversion and parsing of input document information...', col. 26, lines 46-53, 'The publisher format conversion units 916 of the format conversion block 912 control the parsing and conversion of the input document information from the various publisher-specific formats into the universal publisher processing format supported by the information retrieval system 100...') the text, request to identify the unique identifier (col. 26, 46-57, col. 27, lines 9-23); requesting the electronic file identified by the unique identifier (Abstract, lines 22-24, '...the ability to retrieve a document in response to the retrieval request and transmitting a file representative of the document...', col. 10, lines 9-15, 'For each search term listed in the document index database 117, document index database 117 stores the document identification number corresponding to each document file (stored in image/text database 118) that includes that search term, along with location information corresponding to the location of the search term in each such document file.', col. 9, lines 27-53, col. 10, lines 5-15, col. 12, lines 15-67, col. 13, lines 1-24).

13.   Regarding Claims 2, 10, and 36, Barr teaches providing the unique identifiers to
a user for selection of one or more of the unique identifiers (col. 14, lines 41-51); and
querying a user to order the file identified by the selected unique identifiers (col. 14,
lines 1-51).

14.   Regarding Claims 3, 11, and 37, Barr teaches querying a user for delivery of a
file identified by the selected unique identifiers (col. 14, lines 1-51).

15.   Regarding Claims 4, 12, 25, and 38, Barr teaches files identified by the selected
unique identifiers are delivered as a bundle (col. 8, lines 53-67, col. 14, lines 1-51).

16.   Regarding Claims 5, 13, 26, and 39, Barr teaches receiving in a browser window
a text request selected from another window (col. 14, lines 41-58).

17.   Regarding Claims 6, 17, 30, and 43, Barr teaches the file is selected from a
group comprising multimedia files, image files, document files, and program files (col. 9,
line 63, col. 10, lines 20-23).

18.   Regarding Claims 7, 31, and 18, Barr teaches a client computer (figure 1,
element 102).

19.   Regarding Claims 8, 19, 32, and 45, Barr teaches a server computer (figure 1,
element 114).

20.   Regarding Claims 14, 27, and 40, Barr teaches the item is an electronic file (col.
9, lines 54-67, col. 10, lines 1-23).

21.   Regarding Claims 15, 28, and 41, Barr teaches a consumer product (col. 11,
lines 28-67).

22.   Regarding Claims 16, 29, and 42, Barr teaches the item is a service (col. 11,
lines 28-67).

23.   Regarding Claim 22, Barr teaches a request module receiving a unique identifier
and unformatted data (figure 9A, elements 908a-908b 'Unconverted image text-type

information and Unconverted text-type information', col. 12, lines 24-35) wherein the

unique identifier identifies (col. 13, lines 1-24, 'for each search term listed in the

document index database 117, document index database 117 stores the document

identification number corresponding to each multi-media file having an associated text

field which includes that search term...') an item (col. 9, lines 27-53, col. 10, lines 5-15,

col. 12, lines 15-67, col. 13, lines 1-24); a parser module (col. 26, lines 46-53, 'The

publisher format conversion units 916 of the format conversion block 912 control the

parsing and conversion of the input document information from the various publisher-

specific formats into the universal publisher processing format supported by the

information retrieval system 100...') , the unique identifier (col. 26, 46-57, col. 27, lines

9-23); an order module that enables a server system to process an order for the item

identified by the unique identifier (Abstract, lines 1-28).

24.   Regarding Claim 23, Barr teaches a display module that provides the unique

identifiers to a user for selection of one or more of the unique identifiers (col. 14, lines 1-

51).

25.   Regarding Claim 24, Barr teaches a query module that requests that requests

that a user select for delivery an item identified by the selected unique identifiers (col.

14, lines 1-51).

26.   Regarding Claim 20, 33, and 46, Barr teaches the request comprises text (col. 9,

lines 54-67, col. 10, lines 1-23).

27.   Regarding Claim 34, Barr teaches the request comprises an image (col. 9, lines

54-67, col. 10, lines 1-23).

28.   Regarding Claims 21 and 47, Barr teaches an image and the parsing stem

comprises the step of matching the image to a unique image (col. 14, lines 38-67, col.

15, lines 1-48).

Claim Rejections - 35 USC § 103

29.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed
> or described as set forth in section 102 of this title, if the differences between the
> subject matter sought to be patented and the prior art are such that the subject
> matter as a whole would have been obvious at the time the invention was made
> to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was
> made.

30.   The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.

2.   Ascertaining the differences between the prior art and the claims at issue.

3.   Resolving the level of ordinary skill in the pertinent art.

4.   Considering objective evidence present in the application indicating

obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

31.   Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barr et

al. (Pat. No. 5,873,076 filed 9/15/1995, hereinafter Barr) as applied to claim 35 above,

and further in view of Himmel et al. (6,408,316 B1 filed 12/17/1998, hereinafter Himmel).

32.   Regarding Claim 44, Barr teaches a client computer (figure 1, element 102).

However, Barr does not expressly teach a Java applet.

Himmel teaches a bookmark set creation according to user selection of selected

pages satisfying a search condition.

The method and associated system for a bookmark set creation according to

user selection of selected pages satisfying a search condition as taught or suggested by

Himmel includes:

a Java applet (col. 4, line 52 and 53).

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to combine Barr's search query method to identify and retrieve

documents with Himmel's method to search pages of a distributed database comprising

a Java applet because Himmel's Java applet could enable Barr's search query method

to record events of a user's ability to request and retrieve documents and files within the

distributed data interface.

33.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Conclusion

34.   The prior art made of record and not relied upon is considered pertinent to

Applicant's disclosure.

Name of Contact

35.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Cheryl Lewis whose telephone number is 703-305-8750.

The examiner can normally be reached on Mon-Thur from 6:30 to 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John E. Breene can be reached on 703-305-9790. The TC (technology

center) for group 2100 customer service number is 703-306-5631.

The fax phone numbers for the organization where the application or proceeding

is assigned are as follows:

(703) 746-7238   (After Final Communication)

or:

(703) 872-9306   (Official Communications)

(703) 746-7240   (For Status inquiries, draft communication)

any/or:

(703) 746-5651 (Use this FAX #, only after approval by Examiner, for

"INFORMAL" or "DRAFT" communication. Examiners may request that a formal

paper/amendment be faxed directly to them on occasions.)

Any inquiry of a general nature of this application or proceeding should be

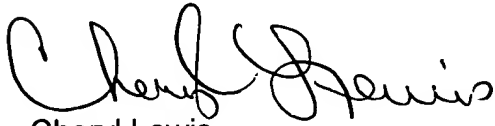directed to the receptionist whose telephone number is 703-305-3900.

Hand-delivered responses should be brought to Crystal Park II, 2121

Crystal Drive, Arlington, VA., Fourth Floor (Receptionist).

Cheryl Lewis
Patent Examiner
September 22, 2003

Hand-delivered responses should be brought to Crystal Park II, 2121

Crystal Drive, Arlington, VA., Fourth Floor (Receptionist).

Cheryl Lewis
Patent Examiner
September 22, 2003

SRIRAMA CHANNAVAJJALA
PRIMARY EXAMINER